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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/835,495	04/17/2001	Katsumi Okouchi	01081	5421

7590

09/17/2002

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EXAMINER

ASHLEY, BOYER DOLINGER

ART UNIT

PAPER NUMBER

3724

DATE MAILED: 09/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/835,495

Applicant(s)

OKOUCHI, KATSUMI

Examiner

Boyer D. Ashley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-25 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-17, drawn to a cutting tool having a power supply with a transformer and cooling device, classified in class 83, subclass 520.
 - II. Claims 18-22, drawn to a cutting tool having a power supply circuit with first and second circuits and a coupling, classified in class 30, subclass 376.***.
 - III. Claims 23-25, drawn to a method of illuminating a workpiece, classified in class 83, subclass 13.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions of Groups I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because it can be used without the first and second circuit portions and the coupling. The subcombination has separate utility such as it could be used without the transformer and cooling device of Group I.
3. Inventions of Groups III and I/II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as

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claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, e.g., the process as claimed can be practiced by another materially different apparatus such as an apparatus not having the transformer, cooling device and/or the first and second circuits and coupling.

4. If the applicant elects Group I above the applicant must further elect between the following groups:

A. Claims 2-7, drawn to a cutting tool comprising a mounting device with a cover member with a space for the power supply circuit, classified in class 30, subclass 388.

B. Claims 8-9, drawn to a cutting tool comprising a cooling device for cooling the light in operation, classified in class 83, subclass 520.

C. Claims 10-15, drawn to a portable circular saw cutting tool comprising with base adapted to contact the workpiece and a power supply with a transformer, classified in class 30, subclass 376.

D. Claims 16-17, drawn to a combination of a cutting tool with a mounting device, cover, cooling device, and power supply, classified in class 30, subclass 517.

5. It should be noted that claim 1 is common to groups A-D. If claim 1 is ultimately determined to be allowable without the subject matter of the depending claims, rejoinder of said depending claims will be considered.

6. The inventions can be shown to be distinct, for the following reason:

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7. Inventions of Groups D and A-C are related as combination and subcombination. Inventions in this relationship are distinct if there is evidence that the combination does not rely on the subcombination for patentability. See MPEP 806.05(c), example 3. For example, Group A is evidence that the combination of Group D does not rely on the power supply and transformer of Group B for patentability, and conversely, Group B is evidence that the combination of Group D does not rely on the cooling device of Group A for patentability.

8. Inventions of Groups A-C are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. For example, invention of Group A has separate utility such as it could be used without the power supply and transformer of Group C; and conversely, the invention of Group C has separate utility such as it could be used without the mounting device and cover of Group A. See MPEP § 806.05(d).

9. If the applicant elects Group II above the applicant must further elect between the following groups:

X. Claim 19, drawn to a cutting tool comprising a first/second circuit and a mounting device disposed within the blade case, classified in class 30, subclass 388.

Y. Claims 20-21, drawn to a cutting tool comprising a recess formed in an outer surface of the cutting tool and a coupling cover, classified in class 30, subclass 390.

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Z. Claim 22, drawn to a cutting tool with a coupling that automatically connects the first and second circuit portions when the blade case and the motor housing are joined to each other, classified in class 362, subclass 253.

10. It should be noted that claim 18 is common to groups X, Y, and Z. If claim 18 is ultimately determined to be allowable without the subject matter of the depending claims, rejoinder of said depending claims will be considered.

11. The inventions can be shown to be distinct, for the following reason:

12. Inventions of Groups X, Y, and Z are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. For example, invention of Group X has separate utility such as it could be used without the recess formed in the outer surface of the cutting tool and a coupling cover of Group Y; and conversely, the invention of Group Y has separate utility such as it could be used without the first/second circuit and mounting device of Group X. See MPEP § 806.05(d).

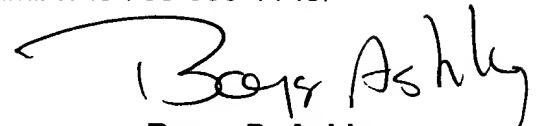
13. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Boyer Ashley whose telephone number is 703-308-1845. The examiner can normally be reached on Monday thru Thursday between 7:30am and 6:00pm. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 703-308-1082.

In lieu of mailing, it is encouraged that all formal responses be faxed to 703-872-9302. Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is 703-308-1148.



Boyer D. Ashley
Primary Examiner
Art Unit 3724

bda
September 9, 2002